

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 1-11 are pending in the present application. Claims 1 and 9 have been amended to address the formal matters raised in the outstanding Official Action. At this time, applicants would like to thank the Examiner for his careful attention to detail in reviewing the present application. Indeed, HEMA is not recognized as hydroxyethylmethacrylate. The specification and claims have been amended to correct this informality.

In the outstanding Official Action, claims 1-11 were rejected under 35 USC §112, second paragraph, for allegedly being indefinite. This rejection is respectfully traversed.

As to the term "grafted with hydroxyethylmethacrylate", the test device itself is grafted with HEMA. Thus, the surface of the test device of the present invention is coated with HEMA, resulting in a HEMA layer. The surface may be grafted with a polymer in a variety of ways known to one skilled in the art. Applicants believe that this is exemplified at page 12 in the present specification, which discloses the gamma irradiation of polypropylene minicards in a 20% HEMA solution in methanol/water (80/20) at a dose of 30-50 kGy. A polypropylene minicard coated with HEMA is obtained.

Claim 9 was rejected for reciting the phrase "library of peptides". However, claim 9 has been amended so that this phrase no longer appears in the claims.

Thus, in view of the above, applicants believe that claims 1-11 are definite to one skilled in the art.

Claims 1-9 were rejected under 35 USC §103(a) as allegedly being unpatentable over BERENSON et al. This rejection is respectfully traversed.

In imposing the rejection, the Official Action acknowledges that BERENSON et al. do not teach the claimed volume, depth and diameter of the microtiter wells. Rather, the Official Action alleges that it would have been obvious to one skilled in the art to optimize these parameters.

However, applicants respectfully submit that these recitations of the claimed device were not merely a matter of conventional size variations. Indeed, contrary to the assertions of the Official Action, at the time the application was filed, there was a prejudice in the art against such small volumes because of the poor rinsability of the wells. Thus, a skilled person would not minimize the size, depth or volume of a conventional microtiter well as set forth in the claimed invention. Indeed, as noted on page 4 of the present specification, the present invention relates to a test device which solves the miniaturization problems relating to microtiter wells and is suitable for use for biochemical and immunochemical

tests such as ELISA and tests in which peptide syntheses are used.

Moreover, the Examiner is respectfully reminded that a particular parameter where a variable must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the parameter or variable might be characterized as routine or obvious. *In re Antonie*, 559 F.2d 618, 195 USPQ 6, (CCPA 1977); see also *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Indeed, upon reviewing the BERENSON et al. publication, applicants note that BERENSON et al. fail to teach that the claimed recitations are merely result-effective variables. As a result, applicants believe that the Office Action fails to meet its burden in showing that the claimed recitations may be characterized as routine or obvious. While the Official Action cites to *In re Rose* and *In re Daly* (citations omitted), applicants note that the size and configuration are not a mere matter of choice. Indeed, as noted above, the conventional wisdom would teach away from the claimed volume, depth and diameter of the wells.

Thus, in view of the above, applicants believe that BERENSON et al. fail to render obvious the claimed invention.

In the outstanding Official Action, claims 1-11 were also rejected under 35 USC §103(a) as allegedly being unpatentable over STEDRONSKY. This rejection is respectfully traversed.

In imposing the rejection, the Official Action states that the Office is using the 1/5/01 filing date for the subject matter covered by the instant claims. Moreover, the Official Action states that the Office will assume the claims contain new subject matter that is not entitled to the earlier filing date before 1/5/01. However, this position is improper as a matter of law.

As the Examiner is aware, a continuation-in-part (CIP) application is a type of continuing application that discloses at least some of the same subject matter disclosed in a co-pending parent application. A CIP application is usually thought of as including "new matter", which the Office typically defines broadly as subject matter not found in the parent application. However, the designation of an application as a CIP does not, by itself, have any legal effect whatsoever on the question of whether the claims in the CIP are entitled to the filing date of a parent application.

Claims that are fully supported by the disclosure found in the parent application are entitled to the benefit of the filing date from that application. Claims which depend upon the new disclosure of the CIP application for enablement, written description, and/or best mode, are not entitled to the benefit of the filing date from the parent application. Claims of the parent case that are carried over into the CIP application or are new will be entitled to the filing date of the parent application

as long as the parent application contains sufficient disclosure to support the claims.

Thus, contrary to the position taken by the Office, a CIP application may therefore contain some or all claims that are entitled to the benefit of a parent application filing date. Calling an application a CIP communicates no information concerning the effective filing date of any claims contained in such application. See MPEP Statute 201.08.

The STEDRONSKY patent was filed on November 21, 1994 and did not issue until June 2, 1998. The present application is a continuation-in-part application of U.S. Application Serial No. 08/811,959, filed March 5, 1997, which is a continuation of U.S. Application Serial No. 08/244,228, filed July 25, 1994, which was a national stage of PCT/NL92/00213, filed November 20, 1992. As the Office Action does not present any evidence that shows that the claims of the present invention are not entitled to the filing dates of the above-identified applications, applicants believe that STEDRONSKY fails to qualify as prior art.

In addition, applicants note that STEDRONSKY, like BERENSON et al., fail to teach the claimed volume, depth and diameter of the wells. Indeed, on page 5 of the Official Action, it is acknowledged that STEDRONSKY is silent to the claimed volume of the microtiter wells, their depth to diameter ratio and their density on the plate.

As STEDRONSKY fails to suggest these claimed recitations and the one skilled in the art would actually be dissuaded from using these parameters, applicants believe that STEDRONSKY fails to render obvious the claimed invention.

Claims 9-11 were rejected under 35 USC §103(a) as allegedly being unpatentable over LAM et al. This rejection is respectfully traversed.

LAM et al. is directed to a multi-well test device that comprises a number of peptides. LAM et al. fail to disclose or suggest the claimed volume of the microtiter wells.

While the Office Action contends that it would be obvious to one skilled in the art to optimize the volume of the microtiter wells, applicants again note that a particular parameter or variable must first be recognized as a result-effective variable before the determination of the parameter or variable might be characterized as routine or obvious. As acknowledged by the Office Action, LAM et al. is silent as to this feature. Moreover, as noted above, applicants believe that the conventional wisdom teaches away from this feature. As a result, applicants believe that Lam et al. fail to render obvious the claimed invention.

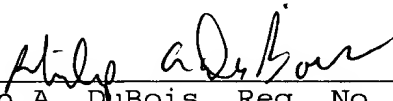
In view of the present amendment and the foregoing remarks, therefore, applicants believe that the present application is now in condition for allowance at the time of the

next Official Action, with claims 1-11, as presented. Allowance and passage on this basis are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON


Philip A. DuBois, Reg. No. 50,696
745 South 23rd Street
Arlington, VA 22202
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

PD/mjr
January 3, 2005